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## REMARKS

Applicant thanks the Examiner for his thoughtful review of the present application.

The status of the claims is as follows:

- a. **Claims 1-18 are Pending** in the present application.
- b. **Claims 1-18 are rejected.**

i. **ARGUMENT**

**2. Claim Rejections - 35 U.S.C. §103**

The standard for making an obviousness rejection is currently set forth in MPEP 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. **Second**, there must be a reasonable expectation of success. **Finally**, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The *teaching or suggestion* to make the claimed combination and the *reasonable expectation of success* must *both be found in the prior art, and not based on applicant's disclosure*. (emphasis and formatting added) MPEP § 2143, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a *convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). (emphasis added).

*See also, KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_ (2007).

The Office Action fails to meet this burden. As noted above, the PTO has the burden of establishing a *prima facie* case of obviousness under 35 USC §103. The Patent Office must show that some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_ (2007); *In*

*re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075. In this case, the Examiner has not pointed to any cogent, supportable reason that would lead an artisan of ordinary skill in the art to come up with the claimed invention. ***It is impermissible hindsight reasoning to pick a feature here and there from among the references to construct a hypothetical combination which obviates the claims.***

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. [citation omitted]

*In re Gordon*, 18 USPQ.2d 1885, 1888 (Fed. Cir. 1991).

A large number of devices may exist in the prior art where, if the prior art be disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet Applicants' claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure. The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made."

*Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

*W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a prima facie case for obviousness. *See, KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_ (2007) (obviousness determination requires looking at "whether there was an apparent reason to

combine the known elements in the fashion claimed...", *citing In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," KSR at 14).

a. **Rejection of Claims 1-8, 11-15 and 18 under 35 U.S.C. §103(a) (831, 187 References)**

The Applicant respectfully traverses the rejection of independent **1-8, 11-15 and 18** as being unpatentable over U.S. Patent **6503831** to *Speakman* in view of U.S. Patent **5,235,187** to *Arney et al.*

Independent claim 1 recites a method of making a microelectromechanical system device. The method includes releasing a micromover component and coating the micromover component with a first self-aligned film after releasing the micromover component. *Speakman* generally discloses a method of forming an electronic device using the technique of drop on demand printing to deposit droplets of deposition material, said method comprising depositing a plurality of droplets on a surface to form a patterned electronic device comprising multiple discrete portions. However, as admitted by the Examiner, *Speakman* does not expressly disclose coating the micromover component after releasing the micromover component as recited in the independent claims. Consequently, the *Speakman* reference does not teach every element of the recited in the independent claim.

The Examiner purports to combine the *Speakman* reference with the *Arney et al.* reference to cure *Speakman's* above-delineated defect. *Arney et al.* discloses that self-aligned, opposed, nanometer dimension tips are fabricated in pairs, one of each pair being located on a movable, single crystal beam, with the beam being movable in three dimensions with respect to a substrate carrying the other tip of a pair. Motion of one tip with respect to the other is controlled or sensed by transducers formed on the supporting beams. Spring means in each beam allow axial motion of the beam. The tips and beams are fabricated from single crystal silicon substrate, and the tips may be electrically isolated from the substrate by fabricating insulating segments in the beam structure.

The Examiner specifically asserts that it would have been obvious for one of ordinary skill in the art at the time of the invention, to release the micromover of *Speakman et al* and then coat the micromover for its benefit in forming a micromover as discussed by *Arney et al.* The Examiner further asserts that since both references pertain to

micromovers in MEMS, a *prima facie* case of obviousness is established. Applicant respectfully disagrees.

Although an Examiner may suggest that the structure of a primary prior art reference *could* be modified in view of a secondary prior art reference to form the claimed structure, the mere fact that the prior art *could* be so modified does not make the modification obvious *unless the prior art suggested the desirability of the modification.* *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (CAFC 1989). (Emphasis added.)

In this particular instance, the Examiner proposes to combine the *Speakman* reference with the *Arney et al.* reference to cure *Speakman's* above-delineated defect. The Examiner asserts that the motivation to combine the two references is based on "the benefit as discussed by *Arney et al.*" However, neither the *Speakman* reference nor the *Arney et al.* reference suggest a desirability for the Examiner's proposed modification. As stated above, rejections on obviousness grounds cannot be sustained by mere conclusory statements. Applicant herein asserts that the Examiner's conclusion that the motivation to combine the two references is based on "the benefit as discussed by *Arney et al.*" completely lacks the rational underpinning necessary to sustain an obviousness rejection under 35 U.S.C. §103(a).

Applicant therefore respectfully asserts that the Examiner's proposed combination of references is based on hindsight reasoning and is improper according to the above-outlined patent case law. Accordingly the rejection of independent **Claim 1** as being unpatentable over U.S. Patent 6503831 to *Speakman* in view of U.S. Patent 5,235,187 to *Arney et al.* under 35 U.S.C. §103(a) should be withdrawn.

**Claims 2-8, 11-15 and 18** depend from Independent **Claim 1** and inherit all of it's limitations. Therefore **Claims 2-8, 11-15 and 18** are also patentably distinct in light of U.S. Patent 6503831 to *Speakman* in view of U.S. Patent 5,235,187 to *Arney et al.* and the rejections of **Claims 2-8, 11-15 and 18** under 35 U.S.C. §103(a) ought to now be withdrawn.

**b. Rejection of Claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over Speakman in view of Yao et al.**

Insofar as the *Yao et al* reference fails to correct the outlined deficiency of the *Speakman* reference, Appellant asserts that the Examiner's proposed combination of the

Speakman reference and the Yao et al reference does not teach or suggest the limitations as recited in claims 9 and 10 of the present invention. Furthermore, since claims 9 and 10 are dependent on claim 1, the above-articulated arguments with regard to claim 1 apply with equal force to claims 9 and 10. Accordingly, claims 9 and 10 should be allowed over these references.

**c. Rejection of Claims 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over Speakman in view of Jacobson et al.**

Insofar as the Jacobson et al reference fails to correct the outlined deficiency of the Speakman reference, Appellant asserts that the Examiner's proposed combination of the Speakman reference and the Jacobson et al reference does not teach or suggest the limitations as recited in claims 16 and 17 of the present invention. Furthermore, since claims 16 and 17 are dependent on claim 1, the above-articulated arguments with regard to claim 1 apply with equal force to claims 16 and 17. Accordingly, claims 16 and 17 should be allowed over these references.

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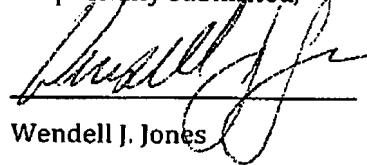
ii. **CONCLUSION**

Applicant now believes the present case to be in condition for allowance. Therefore, the Applicant respectfully requests a Notice of Allowance for this application from the Examiner.

It is believed that all of the pending Claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending Claims (or other Claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any Claim, except as specifically stated in this paper, and the amendment of any Claim does not necessarily signify concession of unpatentability of the Claim prior to its amendment.

Applicant believes that no fees are currently due, however, should any fee be deemed necessary in connection with this Amendment and Response, the Commissioner is authorized to charge deposit account 08-2025.

Respectfully submitted,



Wendell J. Jones

Reg. No. 45,961